

REMARKS

Claims 1-52 are pending in this application. By this Amendment, Applicant has amended claims 5, 20, 25, 43 and 51 and added new claim 53. Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

Information Disclosure Citation:

Sheet 1 of 5 of the Information Disclosure Citation (Form PTO-1449) returned with the outstanding Office Action did not include the Examiner's initials next to the only cited U.S. Patent Document – namely, U.S. Patent No. 5,663,757 to Morales. Applicant respectfully requests that the Examiner return a copy of Sheet 1 with the Examiner's initials next to that reference to show consideration thereof.

Rejections Under 35 U.S.C. §112, ¶2:

Claims 5, 25 and 43 were rejected under 35 U.S.C. §112, ¶2, as being indefinite. Applicant has amended claims 5, 25 and 43 in this regard and respectfully requests that these rejections be withdrawn.

Rejections Under 35 U.S.C. § 103:

Claims 1-4, 7-17, 20-24, 27-34, 41, 42, 44 and 46-52 were rejected under 35 U.S.C. §103 as being unpatentable over Gerszberg in view of Asai. Claims 18, 19, 38 and 39 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Nanba. Claims 5, 25 and 43 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Hyakudai. Claims 40 and 45 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Hamzy. Claims 6 and 26 were rejected under §103 as being

unpatentable over Gerszberg and Asai in view of Munyan. Claims 1, 20, 41 and 50-52 are independent.

Applicant's invention, as defined by claim 1, calls for: "displaying content on a bistable display; transmitting an indication of user inactivity; receiving an advertisement; displaying the advertisement on the display; and removing power to the display, wherein the advertisement remains on the display after power has been removed."

Gerszberg is directed to customer premises equipment that includes video telephones "that are designed to be continuously used without being turned off". (8/9-10) In order to protect the displays on these devices from damage due to burnout, a screen saver advertisement is employed that appears on the display of the video phone in response to user inactivity and then moves across the display. Additionally, the advertisement may initially be displayed at a low light level and then be gradually brightened until a maximum brightness is achieved prior to the advertisement being moved. (8/13-9/56)

Asai is directed to an electronic device with a display having a memory function onto which advertising information is displayed. The advertising information can be maintained on the display without requiring any power consumption. (Abstract)

Applicant respectfully submits that there is no motivation to combine Gerszberg and Asai to arrive at the claimed invention. In particular, there is no motivation to modify Gerszberg to include the memory element display of Asai. First, Gerszberg is not interested in power conservation because the video telephone disclosed therein is not mobile, but instead is plugged into the customer premise's power supply. Second, the screen saver function or, more particularly, the movement of the advertisement across the display during periods of inactivity while power is on is essential to Gerszberg – it is at the very core of the Gertszberg reference.

Thus, one of ordinary skill in the art would not have been motivated to modify Gertszberg to include a bistable display and shut off power to it because doing so would make the screen saver function of Gertszberg entirely unnecessary. That is to say, there would then be no reason to implement the screen saver function of Gertszberg to protect the display on the video telephone from damage due to burnout. For each of the foregoing reasons, Applicant respectfully submits that there is no motivation to modify Gerszberg in view of Asai in the manner suggested in the Office Action in rejecting claim 1.

Accordingly, Applicant respectfully submits that claim 1 is not obvious over Gerszberg in view of Asai. Claim 50 contains limitations similar to those found in claim 1 and is allowable for at least the same reasons.

Applicant's invention, as defined by amended claim 20, is a method for advertising to a user of a mobile terminal, which requires "receiving an advertisement at the time of downloading content; displaying the content on a bistable display; detecting user inactivity with respect to the content; displaying the advertisement on the display; and removing power to the display, wherein the advertisement remains on the display after the power has been removed."

As a preliminary matter, the Office Action rejects claim 20, in part, on the same grounds as claim 1 - - namely, that it would have been obvious to modify Gerszberg to include the memory element display of Asai. For the same reasons set forth above in urging the allowance of claim 1, Applicant respectfully disagrees.

Applicant also traverses the rejection of claim 20 on additional grounds. In particular, the Office action concedes that the feature of "receiving an advertisement at the time

of downloading content" is not disclosed by Gerszberg or Asai. However, the Office Action then states:

"it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerszberg as modified by Asai to receive an advertisement at the time of downloading content to provide geographic or time sensitive advertising targeting a particular geographic location or time sensitive advertising, e.g., advertising with expiration date. Furthermore, it would also conserve the memory space at the central station and ensures that the downloaded advertisement is the most recent and up to date." (Office Action, p. 4)

Applicant respectfully submits that these features would not have been obvious. First, the Office Action's proposed motivation for incorporating the claimed feature into the combination of Gerszberg and Asai is unsupported by the record and, is thus, improper. Second, Applicant also respectfully disagrees with the substance of the proposed motivation set forth in the Office Action. For example, receiving an advertisement at the time of downloading content does not ensure that the downloaded advertisement is up-to-date. This is because an advertisement may be downloaded at a possibly much earlier time (and at a different location) than when it is actually displayed in response to user inactivity. Additionally, receiving an advertisement at the time of downloading content would "conserve the memory space at the central station" only if the central station could then delete the advertisement, which Gerszberg does not say happens. More importantly, receiving an advertisement at the time of downloading content would also increase the memory requirements at the mobile user terminal, a burden which would be far greater on a mobile terminal than a central station given their respective capacities. For the foregoing reasons, Applicant respectfully submits that there is no motivation on the present record to modify the combination of Gerszberg and Asai in the manner set forth in the Office Action in rejecting claim 20.

Accordingly, Applicant respectfully submits that claim 20, as amended, is not obvious over Gerszberg in view of Asai. Amended claim 51 contains limitations similar to those found in amended claim 20, and thus, is allowable for at least the same reasons.

Applicant's invention, as defined by claim 41, is a method of advertising to a user of a terminal having a bistable display, which requires: "storing content; storing advertisements linked to the stored content; receiving a request for content from the user terminal; transmitting the requested content to the user terminal; receiving an indication of user inactivity at the user terminal with respect to the requested content; selecting an advertisement linked to the requested content; and transmitting the selected advertisement to the user terminal for display."

The Office Action states that "Gerszberg and Asai disclose storing advertisements linked to the stored content". Applicant has reviewed the cited references and is unable to identify any support in those references for this proposition, nor does the Office Action provide any. In Gerszberg and Asai, advertisements are not linked to the content; rather, advertisements are stored for display without regard to the content being displayed. See, e.g., Asai, FIG. 2(A) – 2(C) and Gerszberg, FIG. 8.

Accordingly, Applicant respectfully submits that claim 41 is not obvious over Gerszberg in view of Asai. Claim 52 contains limitations similar to those found in claim 41, and thus, is allowable for at least the same reasons.

Dependent Claims:

With respect to at least dependent claim 44, the Office Action has admitted that neither Gerszberg nor Asai discloses the features added by this claim. Nevertheless, the Office Action has taken the position that these features would have been obvious without providing any evidence of (1) the knowledge of one of ordinary skill in the art concerning these features

at the time the invention was made and (2) the stated motivation to incorporate these features into Gerszberg and Asai. Applicant respectfully submits that this feature would not have been obvious and, that the Office Action's statements to the contrary are unsupported and, are thus, improper.

Applicant does not believe it necessary at this time to further address the rejections of the dependent claims as Applicant believes that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicant, however, reserves the right to address those rejections in the future should such a response be deemed necessary and appropriate.

New Claim:

New claim 53 is presented for examination. Applicant respectfully submits that the features claimed therein are neither taught nor suggested by the prior art. For example, neither Gerszberg nor Asai teach or suggest the feature of "at least removing power to the display after displaying the advertisement, wherein the advertisement remains on the display after power has been removed and wherein power remains removed until user activity is detected."

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Dated: February 27, 2004

By:

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